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Facsimile No.:	571-273-8300	
From:	Michael E. Hudzinski	
Re:	Our Ref.: SVL920010005US1 – Serial No. 09/829,721 (IBMZ 2 00004)	

COMMENTS

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: **SMITH, et al.**

Application No.: 09/829,721

Examiner: Gregory J.
Vaughn

Filed: April 10, 2001

Docket No.:
SVL920010005US1
(IBMZ 2 00004)

For: TEXT ENTRY DIALOG BOX SYSTEM AND METHOD OF USING SAME

MAIL STOP REPLY BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF UNDER 37 C.F.R. § 41.41

Dear Sir:

Applicants transmit herewith one (1) originally signed copy of a REPLY BRIEF
UNDER 37 C.F.R. § 41.41 for the above-identified patent application.

Payment for the filing of this Reply Brief and any appropriate extension of time
fees are authorized to be charged to Deposit Account No. 09-0460. Please charge any
and all fees or credit any overpayment to Deposit Account No. 09-0460.

Respectfully submitted,

FAY SHARPE LLP

19 MAR 07
Date

Michael E. Hudzinski
Michael E. Hudzinski, Reg. No. 34,185
1100 Superior Avenue, Seventh Floor
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PATENT APPLICATION

THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

SMITH, et al.

Application No.: 09/829,721

Examiner: Gregory J. Vaughn

Filed: April 10, 2001

Docket No.: SVL920010005US1
(IBMZ 2 00004)

For: TEXT ENTRY DIALOG BOX SYSTEM AND METHOD OF USING SAME

REPLY BRIEF

(37 C.F.R. § 41.41)

Appeal from Group 2178

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Date: March 19, 2007	Name: LAURIE A. BOYLAN

I. REAL PARTY IN INTEREST

Both the Examiner and Appellants agree that the real party in interest for this appeal and the present application is International Business Machines Corporation, by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 011720, Frame 0530.

II. RELATED APPEALS AND INTERFERENCES

The Examiner is unaware of any related appeals, interferences, or judicial proceedings, and Appellants have stated in the record that there are no such appeal, interferences or judicial proceedings known to Appellants that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Both the Examiner and Appellants agree that the status of claims contained in the Appeal Brief is correct.

IV. STATUS OF AMENDMENTS AFTER FINAL

Both the Examiner and Appellants agree that the statement of the status of amendments after final rejection contained in the Appeal Brief is correct.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Both the Examiner and Appellants agree that the summary of claimed subject matter as set out in the Appeal Brief is correct.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Both the Examiner and Appellants agree that the statement of grounds of rejection to be reviewed on appeal as set out in the Appeal Brief is correct.

VII. CLAIMS APPENDIX

Both the Examiner and Appellants agree that the copy of the appealed claims contained in the Appendix portion of the Appeal Brief is correct.

VIII. EVIDENCE APPENDIX

Both the Examiner and Appellants agree that the evidence relied upon by the Examiner in the instant appeal is as follows:

1. Microsoft Word, copyright 1993-1999 by Microsoft Corporation (hereinafter MS Word) note: screenshots of the software application running on the Examiner's computer workstation are used as prior art.
2. William B. Hayes using PowerBuilder 6, published by QUE Corporation in 1997, (hereinafter PowerBuilder 6).

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Application No. 09/829,721

IX. GROUNDS OF REJECTION

Both the Examiner and Appellants agree that claims 2, 3, 6-8, 11-13, 15, 16, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over MS Word, in view of PowerBuilder 6.

X. RESPONSE TO ARGUMENT

A. The Examiner's response to Appellants' argument that there is a lack of motivation to combine MS Word and PowerBuilder 6:

The Examiner has once again taken a position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the MS Word find and replace text entry dialog box with the selectively displayed controls as taught by PowerBuilder 6 in order to provide a visible indication that the control is usable. To this, Appellants assert that the teachings of MS Word are merely cumulative to the background prior art and to the references of record, and that the Examiner has not demonstrated an equivalence between a scroll bar and a selection button of the type described and claimed in the present application.

In addition, the Examiner has created an artificial set of circumstances in order to support a position that PowerBuilder 6 displays a scroll bar conditional upon an empty memory. According to the Examiner, "if the list box is set to a height equivalent to less than one line of text, and the memory is empty, then the scroll bar would not be displayed" as set out on page 6 of the Examiner's Answer. Since it is assumed that the quantity of valid entries into the list box setting is an integer, then logically a list box set to a height equivalent to less than one line of text would imply a list box set to a height

of zero lines of text. Therefore, using the Examiner's artificial example, the list box itself would be useless and would have no utility since a list box set to a height equal to zero will show nothing to the user of the system, and, therefore, the presence or absence of a scroll bar or any other controls or control like features would be clearly irrelevant.

In addition to the above, the cited dialog window of FIGURES 5-7 merely shows what the Background of the present application previously described as prior art – a free-form text entry dialog box with drop-down list of prior text entries, in which the drop-down list button is always displayed. Such dialog boxes are confusing particularly to novice users who are likely to believe it is a pure drop-down selection box. Those users are further confused when operation of the drop-down list button fails to provide a list of selectable entries. Confused users may also fail to recognize the free-form text entry option and may therefore fail to successfully interact with the dialog box, or may be substantially delayed in successful interaction due to the aforementioned confusion.

PowerBuilder 6 does not help alleviate the confusion because it only provides for certain selectively displayable selection buttons. The Examiner states that PowerBuilder 6 discloses selectively displaying a text entry box control, based upon the number of items in memory. If the list box is set to a height equivalent to less than one line of text, and the memory is empty, then the scroll bar would not be displayed. This example is impractical. The scroll bar is visible only when the memory holds one or more text items. Appellants argued earlier and argue again now that while PowerBuilder 6 displays a form of a control button, the scroll bar control button alone without prior text input does not indicate to the user the input functionality associated with the text entry box. In other words, the presence of a scroll bar alone does not indicate to users that text can be entered into another associated text box. The scroll

bar provides no invitation to the user to enter text into any text box but rather it simply invites the user to select from the items in the list presented. This is in stark contrast with embodiments of the present invention which provide a free-form text entry dialog box, which to a user appears as a conventional text box (as discussed with reference to the prior art). In addition, and only when appropriate, the free-form text entry dialog box includes a drop-down arrow indicating to a user whether previous entries are available, without confusing the user into thinking that new or original entries can be made into that text entry box.

With respect to the MS Word reference, the first example relates to showing a selection arrow upon focus. Such a selective displaying, even if incorporated into the cited MS Word dialog box, would not solve the problem of user confusion. It would merely delay the user's confusion until he or she focuses the mouse pointer onto the dialog box. The second example relates to a list box which does not provide free-form text entry – hence, the Office Action's characterization of this example as disclosing "selectively displaying a text entry box control" is inaccurate.

None of the previously or newly cited portions of MS Word, PowerBuilder 6, or their combination, disclose or fairly suggest the features of claim 2 (at least the feature "means for selectively displaying a selection button on the screen of the display device in association with the dialog box for selection by the pointing means, the selection button being displayed solely when the memory contains at least one previously entered text item" is not disclosed), claim 8 (at least the feature "displaying a drop-down list selection button on the screen of the display device only if the counting produces a value greater than zero" is not disclosed), and claim 21 (at least the feature "a

drop-down list selection button displayed in conjunction with the free-form text entry portion only when the memory contains at least one previously entered free-form text entry" is not disclosed). It should be noted the above referenced claims – 2, 8 and 21 – describe the coupling of input features and the list viewing features. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

B. The Examiner's response to Appellants' argument that the motivation to combine MS Word and PowerBuilder 6 is taken from the present application:

The Examiner has tendered statements in his Reply Brief in response to Appellants' arguments that the motivation to combine MS Word and PowerBuilder 6 is taken from the present application. Here, the Examiner has stated that "PowerBuilder 6 provides additional motivation to combine the references" on page 6 of the Examiner's Answer. The Examiner cites to PowerBuilder 6, at page 3, second paragraph where at the "allow editing" feature is described. On page 5 of the Answer, however, the Examiner clearly states that "MS Word fails to disclose the selective display of a selection button (i.e. the show-list- button) associated with the dialog box, where the selection button is visible when at least one text entry is stored in memory." The Examiner has failed to articulate and set into the record how PowerBuilder 6 provides additional motivation to combine the references based upon the "allow editing" feature where the Examiner admits the MS Word document fails to disclose the selective display of a selection button associated with a dialog box.

Next in the Examiner's Answer on page 6, the Examiner takes the position that "Appellants' arguments describe inventive features that are not claimed." The Examiner

cites the Appeal Brief filed on October 23, 2006 at page 6 where at Appellants indicate that "confused users may also fail to recognize the free-form text entry option (which is only viable option upon initially opening the dialog window)." The Examiner has fully recognized that the claimed invention indicates that the state of the memory dictates whether the selection button is displayed, so that opening the dialog window has two possible conditions depending on whether the memory is empty or not empty. Thus, the Examiner is correct that "if the memory is empty, then the button is not displayed, but if the memory is not empty, then the button is displayed" as set out by the Examiner on page 7. Along those lines, independent claim 2 includes limitations of a "selection button being displayed solely when the memory contains at least one previously entered text item" which, as described in the present application alleviates confusion by users of the system when using text input boxes.

Along the above lines, again, the Examiner's example of a list box being set to a height equivalent to less than one line of text is irrelevant as that example would result in a list box having a height equivalent to zero lines of text, essentially obliterating the list box. Simply, the Examiner's example is impractical and has no apparent value. This example would frustrate the purpose of PowerBuilder 6.

Still further, in addition, the scroll bar taught in PowerBuilder 6 is not at all an invitation for a user to input text, rather, to control the display of text for later selection. Still further, Appellants' previous Response noted that in the Office Action mailed September 30, 2005 the motivation for the proposed combination of MS Word and PowerBuilder 6 is taken from the present application. In response, the Examiner in the Office Action states:

But so long as it [judgment of obviousness] takes into

account only knowledge which was with the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper.

Office Action at page 7.

As stated previously, it is submitted again that the Office Actions to date do not propose a motivation for making the combination. Appellants reemphasize that the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. The references do not recognize that there is a problem with the combination box that is explicitly taught in cited MS Word FIGURES 5-7. MS Word certainly does not recognize the problem of confusion – it employs precisely the type of combination box that can confuse novice users. PowerBuilder 6 does not recognize the problem – although it provides selectively displayed selectors for viewing lists, neither of the two selectively displayed selectors cited in the Office Action are directed toward alleviating the source of confusion addressed by the present application. The references cannot motivate making a combination to solve a problem that is not recognized in any of the references.

Because the Office Action does not provide a motivation for making the combination and none of the art applied recognizes the problem solved by the present application, a *prima facie* case of obviousness has not been made. Accordingly, Appellants have no duty to present rebuttal evidence supporting patentability.

C. The Examiner's response to Appellants' argument that MS Word teaches away from the combination with PowerBuilder 6:

The Examiner made no response to Appellants' argument that MS Word teaches away from the claims of the present application. Appellants reemphasize that the

references themselves teach away from the proposed combination. It is improper to combine references where the references teach away from their combination. MPEP § 2145, citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A *prima facie* case of obvious may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. MPEP § 2144.05, citing *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Here, the MS Word reference clearly teaches away from the claims of the present application. MS Word discloses precisely the type of prior art combination box which the present application recognizes as confusing. But, MS Word does not recognize it as confusing – rather, MS Word employs that very combination box in a widely sold commercial word processing package. The skilled artisan considering MS Word would likely conclude that this combination box is entirely adequate, and would not be motivated to consider attempting to improve the dialog box. MS Word offers a text entry dialog box that looks to the user like a dialog list box on the display when no text entries have yet been added. This is shown in FIGS. 3a, 3b of the present application. This is the MS Word solution and MS Word presents no other choices. PowerBuilder 6 shows a scroll bar which invites scrolling of previously entered text but does not invite the entry of any new text at all.

Advantages provided by the present application, however, are directed to enhancing the usability of GUI interfaces by providing an improved text entry box that conveys to novice users that text entry can be performed; and, in the event that previous text entries are available, a drop down arrow is included to enable selection of the previous entries.

The cited references, either alone or in combination, fail to disclose or fairly suggest all the elements of the claims of the present application. For example, the cited references alone or in combination do not disclose or fairly suggest the element of claim 21 that a drop-down list selection button be displayed in conjunction with a free-form text entry portion only when a memory contains at least one previously entered free-form text entry. Stated another way, the cited references do not disclose or fairly suggest a drop-down list-selection feature coupled with a free-form text entry feature.

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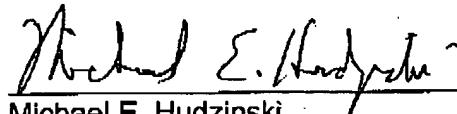
CONCLUSION

In view of the foregoing remarks, Appellants respectfully request that the application be reconsidered and all pending claims be allowed.

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22 are in condition for allowance.

For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22.

Respectfully submitted,



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